



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,039	12/28/2001	Carl I. Green	42390.P13009	1948

8791 7590 09/10/2004

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER

NELSON, ALECIA DIANE

ART UNIT	PAPER NUMBER
----------	--------------

2675

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/041,039

Applicant(s)

GREEN, CARL I.

Examiner

Alecia D. Nelson

Art Unit

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-11 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-11,13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 135 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. ***Claims 1-6, 8-11, and 13-15***, and are, rejected under 35 U.S.C. 103(a) as being unpatentable over Ano (U.S. Patent Application Publication 2002/0030665) in view of Douglas (U.S. Patent No. 5,156,049).

With reference to **claims 1, 8, 9, and 13**, Ano teaches portable information device (1) including an input device (4) wherein a wheel (8) is positioned horizontally relative to the keyboard surface of the portable computer (1') (see paragraphs 93-94), wherein rotation of the wheel (8) communicates user input to the computer (see paragraphs 99-101). With further reference to **claims 2, 10, and 14**, Ano also teaches that the wheel is positioned below a space bar (not labeled) of the keyboard (4) surface substantially in a center of the keyboard (see Figures 1-2). The wheel (8) includes a tracking device (18) to provide user input to direct a cursor (35) displayed on a display of the portable computer (see paragraphs 99-101), wherein the tracking device (5) is placed substantially in a center of the wheel (8) (see Figures 1-2).

With reference to the **claims 1, 8, 9, 13, and 14** Ano fails to teach that the rotation of the wheel provides variable input to an application being executed on the computer. It is taught that the wheel is capable of being used to move images, browse through frames of images, as well as control the vertical tool bar (see paragraphs 100-102). Moreover, it would be obvious to allow the wheel to control variable input as of function of the application be executed. Douglas teaches a manual input system wherein a computer (23) drives a plurality of displays (31, 33, 35, 37), wherein each display includes a three-digit seven-segment display (39). Located below the respective displays are knobs (13, 15, 17), wherein each knob has associated indicia indicating the proper direction of rotation for increasing the corresponding parameter, and rotating the knob in the opposite direction decreases the parameter (see column 4, lines 18-56).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention for the wheel device of Ano to be capable of providing variable input wherein rotation in one direction causes the variable to increase and rotation in the opposite direction causes the variable to decrease, as taught by Douglas to thereby allow for applications including numerical data to be controlled by rotation of the wheel device. This thereby allows the user to control more functions with out having to change hand placement.

With reference to **claim 3**, Ano teaches that the wheel (8) includes a tracking device (18) to provide user input to direct a cursor (35) displayed on a display of the portable computer (see paragraphs 99-101).

Art Unit: 2675

With reference to **claims 4 and 11**, Ano teaches a tracking device (5) is placed substantially in a center of the wheel (8) (see Figures 1-2). With further reference to **claim 11**, it is also taught that the tracking device (5) provides user input to direct a cursor displayed on a display of the portable computer (see figure 107).

With reference to **claim 5**, Ano fails to specifically teach that the wheel includes ridges to provide friction. However, it can be seen in Figure 2, that the wheel includes some type of ridges around the wheel device. Therefore it would have been obvious to one having ordinary skill in the art to include such ridges, or a surface that is not smooth, in order to prevent slippage of the user's finger across the surface of the wheel when rotating the wheel to control the displayed information.

With reference to **claims 6 and 15**, Ano teaches that the wheel is rotated in the clockwise direction to cause the displayed information to scroll downward in the window screen (30), and rotated in the counterclockwise direction to cause the displayed information to scroll upward in the window screen (30) (see paragraphs 100-101).

Response to Arguments

3. Applicant's arguments filed 7/27/04 have been fully considered but they are not persuasive.

The applicant argues that Douglas (U.S. Patent No. 5,156,049) is nonanalogous art to the subject matter claimed by applicant, wherein the applicant's claims are limited

Art Unit: 2675

to an input device on a portable computer and Douglas is directed to automotive test equipment for balancing motor vehicle wheels. However, while Douglas teaches automotive test equipment for balancing motor vehicle wheels the equipment itself includes manual input devices that correspond to displays displaying a parameter wherein each display is controlled by operation of the respective input device wherein the rotation of the wheel provides variable input to the application being executed on the computer. Therefore Douglas is related to the claimed invention.

The applicant further argues that it would not have been obvious to modify to Douglas to be implemented on a portable computer. However, the examiner's view is that it would have been obvious to modify the wheel of Ano to have the ability of variable input by rotation of the wheel as taught by Douglas. The applicant argues the Douglas reference singularly when it is used in combination with Ano. Therefore the rejection will be maintained.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alecia D. Nelson whose telephone number is (703) 305-0143. The examiner can normally be reached on Monday-Friday 9:30-6:00. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2675

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

adn/ADN
September 7, 2004

AMR A. AWAD
PRIMARY EXAMINER

